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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/538,887 | 06/14/2005 | Thomas Hasskerl | 272838US0PCT | 8849 |
| 22850 7590 03/18/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER NAKARANI, DHIRAJLAL S | |
| | | | ART UNIT 1794 | PAPER NUMBER |
| | | | NOTIFICATION DATE 03/18/2008 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/538,887 | Applicant(s) HASSKERL ET AL. | |
| | Examiner D. S. Nakarani | Art Unit 1794 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :08/11/2005, 12/06/2005, 05/04/2006, 06/08/2006 & 09/21/2007.

DETAILED ACTION

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 18, line 2-3, the phrase "the thickness of the coatings (a) and (b) is in the range from 0.1 to 3 μm " renders claim indefinite. It is not clear from the claim language that the recited thickness range is for combined thickness of coatings (a) and (b) or the recited thickness range is for each coatings (a) and (b). Clarification and/or correction requested.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-3, 5-10, 12, 15, 18, 19, 22 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Faverolle et al (U. S. Patent 6,503,631 B1).

Faverolle et al disclose an ophthalmic lens comprising substrate such as polymethyl methacrylate, polycarbonate, etc (Col. 5, lines 1-9) coated with primer comprising two polymers P1 and P2. The polymer P1 is more hydrophobic than polymer P2 (Claim 19). The polymer P2 comprises a small amount of methacrylic acid (Example 4). Therefore the polymer P2 deemed to have water contact angle which falls within the claimed range of water contact angle for the polymer (A). The polymer P1 is made of butyl acrylate. Therefore the polymer P1 deemed to have water contact angle which falls within the claimed range of water contact angle for the polymer (B). Faverolle et al disclose the thickness of the primer coat 1.0 μm , substrate thickness 2.0 mm, thickness of abrasion resistant coat 3.0 μm (Col. 9, lines 7-52). Faverolle et al's abrasion resistant

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coating derived from the coating composition comprising 22 wt% of glycidoxypropyltrimethoxysilane and 62 wt% of colloidal silica. Therefore Faverolle et al's abrasion resistant coating deemed to have inherent property of inhibiting water droplet formation unless shown otherwise.

7. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faverolle et al (U. S. Patent 6,503,631 B1).

Faverolle et al which has been discussed above in paragraph 6, fail to disclose claimed impact strength of plastic substrate, claimed amount of carbon content in the inorganic coating, claimed elasticity modulus of article and claimed scrub resistance. However given the teaching of Faverolle et al, a person of ordinary skill in the art would have found it obvious to select a substrate having desired physical properties for the desired application. A person of ordinary skill in the art would have found it obvious to vary composition and proportion of polymer P1 and P2 based on desired flexibility and adhesion. A person of ordinary skill in the art would have found it obvious to optimize composition of an inorganic coating for desired abrasion resistance.

No claims are allowed.

8. Receipt of Information Disclosure Statements filed August 11, 2005, December 06, 2005, May 04, 2006, June 08, 2006 and September 21, 2007 is acknowledged. All recited documents have been made of record. All recited non-English documents have been considered to the extent of their category shown in the International Search

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Report dated February 19, 2004. All duplicative recited documents have been crossed-out.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. S. Nakarani whose telephone number is (571) 272-1512. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S. Nakarani/
D. S. Nakarani
Primary Examiner
Art Unit 1794

DSN
March 06, 2008.